

From aehoover@interaccess.com Thu Nov 21 15:50:41 1996
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To: regreform@uspto.gov
Subject: Comments

From: Allen E. Hoover (37,354)

In response to the Notice in the Federal Register of September 23, 1996, please consider the following comments pertaining to the change in the rules of patent practice. Please attribute these comments only to myself.

With respect to the proposed requirements of Rule 33, it is submitted that this is a step in the wrong direction. The rule changes reflect a desire to simplify patent procedure and require fewer formalities in the process of obtaining a patent. The proposed change to Rule 33 requires additional effort on the part of patent applicants. If anything, the rule should be changed to require that only "one" of the post office address or the residence address of the inventors be submitted.

This rule presupposes that the Office may wish to contact the inventor directly at his or her residence, and to bypass the the registered practitioner of record. I would be curious as to the number of times such direct contact has occurred. Certainly, such occasions must be infrequent, and it hardly seems worth the burden of obtaining multiple addresses for each inventor on every patent application.

Amendments to Rule 116 are proposed. Under the new rule, as literally read, applicants' ability to respond to final rejections is severely curtailed. In almost every case, a new filing fee will be required when responding after final with new arguments. The "quid pro quo" for the rule change is said to be the elimination of first action final rejections.

This "quid pro quo" ignores the fact that a new filing fee must be paid. Under current practice, the issues that are presented on first rejection often are narrowed by the time the case has progressed through a first response and a subsequent final action. The rejections become more focused, thus enabling applicants to submit focused arguments in response. For these reasons, the applicant and examiner may be able to resolve the outstanding issues in the application without the need to file a continuation application. All this seemingly would not be permitted under the new rule. Read literally, the proposed rule change would eliminate the opportunity for substantive dialogue after a final rejection, but instead would require in every case more paperwork on the part of both the applicant and the Office, not to mention a new filing fee.

The Notice stated that, notwithstanding the language of the Rule, the applicant will still be able to submit amendments after final rejection if the Examiner is agreeable:

(Begin quote)

Section 1.116, as proposed, would not affect the authority of an examiner to enter in an application under final an amendment that places the application in condition for allowance, but does not strictly meet the requirements of Sec. 1.116(a). That is, in instances in which the applicant and examiner agree on an amendment that would place the application in condition for allowance, the examiner would retain the authority to enter the amendment, notwithstanding the requirements of Sec. 1.116(a).

(End quote)

This language seems to authorize more liberal "after final" practice. It is unclear why the Rule would not expressly authorize such practice, if this is the intent of the rule. To resolve this issue, I propose that a new subsection (d) be added to Rule 116:

(Begin)

Notwithstanding the provisions of paragraph (a) of this section, the Examiner may enter and consider any amendment or other reply filed after the mailing date of a final rejection, if the Examiner deems that the prosecution of the application will be ~~deemed~~ materially advanced thereby.

(End)

Under subsection (d), applicants would be free to respond to the final action as appropriate, without the constraints imposed by subsection (a), if the Examiner feels that the prosecution would be advanced thereby.

Thank you for considering these comments.